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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,871	03/19/2004	Albert S. Deutsch	PISCES 02.03	7645
27667	7590	11/20/2006	EXAMINER	
HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,871

Applicant(s)

DEUTSCH, ALBERT S.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The record shows that applicant filed a request for continued examination (RCE) on 22 May 2006 with a three months suspension. Up to date 16 November 2006, the application is up for consideration.

I. I. The MPEP Section 201.11, III, G, 3th paragraph shows that:

"A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional."

It is not a matter of right at this state of the prosecution to normally request amendment to reinsert a benefit claim to a prior application. Applicant is required to file a petition.

Until a petition is granted, the normal request has no value and is not entered.

II. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsch et al (6,315,916 as newly amended on page 1) considered in view of Mori (Pub. 2001/0010892 now Pat. 6,596,462), Damme et al (6,739,260), Thackeray et

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al (6,607,870), Meyrick et al (6,344,497), Tsuji et al (5,849,463), DeBoer et al (5,491,046) and Ehretsmann et al (3,847,265).

Deutsch et al disclose, teach and suggest to a process for imaging a printing plate precursor having thereon a layer containing a diazo compound and deposited thereon with a light absorbing dye composition comprising the steps of jetting ink on the layer, heating and developing. Please see the whole disclosure of each of the applied references, especially in Deutsch et al at col.7:40-57 and Examples.

The language “the near infrared absorbing image material...said imaging layer” is and considered as a property of a material and has been reasonably considered as inherent because of the same or about the same chemical ingredients in the instant application as those in the applied Deutsch et al (6,315,916) which was one being disclosed as the priority application as originally filed. A claim would have no value if Deutsch et al (6,315,916) chemical ingredients are read on the those in the instant claims as broadly disclosed, taught and suggested in the instant application. It is now set forth and notified for the record or a claim may have no value if someone shows that there is an inherent material in one or more of the applied references on the record in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d.

Deutsch et al disclose, teach and suggest a heating step but fail to specify the use of a near infrared emitter as that in the claim. Mori et al at paragraph 0006, lines 3-4 is cited to show the known use of a near infrared emitter for the advantage of providing a near infrared radiation energy as heat to one having ordinary skill in the art at the time the invention was made. There is no suggestion of Mori et al printing plate materials as urged.

Deutsch et al do not specify the embodiments of claims 5, 7, 10 and 14-16, please see Mori et al at col.21:64 with naphthoquinone containing a aromatic group to provide an absorption at 3.2-3.3 microns as those in the specification at page 11:17-18 and claim 5, 21:67 with thioamide with an amid group to provide an absorption at 5.7-61 microns as those in the instant application at page 11:19 and claim 7, 15:46-52 to show binder resin in part of claim 10, 22:22-23 with metal, carbon, graphite and metal oxide being known a ablative materials as that in claim 14, 30:65 to 31:9 to show the known near infrared absorption pigments as those in claims 15-16 for the advantages and efficiencies in using a near infrared heater.

Deutsch et al do not specify an additional washing or rinsing step using water after a developing step as that in claim 2. Damme et al at col.12 :65-66 is cited to show the known use of an additional washing or rinsing step to provide a sufficiently clean plate.

Deutsch et al do not specify (1) a dying step after wet development steps as that in claim 3, (2) novolac (novolak) and a latent bronsted acid as that in part of claim 9, (3) novolac (novolak) and naphthoquinone diazide sulfonic acid ester as that in claims 12. Thackeray et al at col.1:59-62 is cited to show the known use of novolac (novolak) and naphthoquinone diazide sulfonic acid ester as that in claims 12, col.6:42-51 and 8:24-47 is cited to show novolac (novolak) and a latent bronsted acid as that in part of claim 9 and at col.12:44-45 is cited to show a dying step after wet development steps as that in claim 3 for the advantage of obtaining read-to-use image.

Deutsch et al do not specify the embodiments of claims 4 and 6. Meyrick et al at col.7:25-37 is cited to show a pigment having (1) -NH group for an absorption at 2.2-3.2 microns as those in the instant application at page 11:16-17 and claim 4 and (2) aliphatic groups for an absorption in 3.33-3.55 microns as those in the instant application at page 11:18 and claim 6 for the advantages and efficiencies in using a near infrared heater.

Deutsch et al do not specify the embodiments of claims 8, part of 10 and 11. Tsuji et al at col.2:23-30 is cited to show the known polyazide or diazo resin or binder as those in part of claim 8 and claim 13, monomer as part of claim 11. It has a reason that at least some of Tsuji et al (1) monomers (on col.2 :36 to 3:29) are

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heat setting monomer as part of claim 10, (2) polymers (on col.3:35-4:52) are photo-crosslinkable polymers as other part of claim of 8 and (3) initiators (on col.4:57 to 5:12) are heat activated polymerization initiators as part of claim 11 for the advantages and efficiencies of forming a hardened polymer portion. The language “heat setting...”, “photo-crosslinkable...” or “heat activated polymerization initiator” is a property of a material. It is allowed to request and require applicant to provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An argument alone may have and be given a little to no value.

Deutsch et al and Mori do not specify resole and novolac resins and Bronsted acid as that in claim 9. DeBoer at col.3:44-45 is cited to show the known use of resole and novolac resins and a latent Bronsted acid in the art for the advantages of forming polymer layer.

Deutsch et al do not specify a heat setting monomer as in part of claim 10. Ehretsmann et al at col.3:61-63 is cite to show the known use of a heat setting monomer as a film forming agent or binder for the advantages of forming a stable shape.

Since the above references are all related to photo-reactive and -additive materials and processes of obtaining images of photolithographic printing plates, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known use of a near infrared emitter for a reasonable expectation of obtaining the advantage of providing a near infrared radiation energy as heat from Mori et al, washing or rinsing step after a developing step for a reasonable expectation of obtaining a clean plate as disclosed, taught and suggested in Damme et al, use or cite the known use of a drying step after aqueous development steps for a reasonable expectation of obtaining no water contamination to a hydrophobic ink and use or cite novolac resin and Bronsted acid for a reasonable expectation of obtaining a stable film forming layer and novolac and naphthoquinone diazide sulfonic acid ester for a reasonable expectation of obtaining a stable film forming layer as disclosed, taught and obtained in Thackeray et al, use or cite infrared absorption compounds for a reasonable expectations of obtaining the advantages and efficiencies in using a near infrared heater, use or cite diazo resins, photo-crosslinkable polymer, diazide and heat setting monomer binders for a reasonable expectation of obtaining a table film forming layer and use or cited a heat activated polymerization initiator for a reasonable expectation of a heat activating polymerization as disclose, taught and suggested in Tsuji et al, use or cite resole and novolac resins and latent Bronsted acid for a reasonable expectation of forming a stable film forming layer as

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disclosed, taught and suggested in DeBoer et al and use or cite heat setting monomer for a reasonable expectation or obtaining a stable film forming layer as disclosed, taught and suggested in Ehretsmann et al.

III. Applicant's arguments filed on 02 December 2005 have been fully considered but they are not persuasive.

There is no suggestion of Mori et al printing plate materials as urged by applicant in the above rejection.

Applicant urges that “the near infrared absorbing image is not changed” has and is given a little to no value since the embodiment as urged is not in the instant claims or specification. The arguments are related to and considered as a property of a material. It is allowed by law to provided a support for the arguments by convincingly shown with an evidence in accordance with the authority stated in In re Schreiber, 44 USPQ2d.

Applicant urges that the near infrared absorbing material does not act or has a property as a mask in a development process has and is given a little to no value since the embodiment as urged is not in the instant claims or specification. The arguments are related to and considered as a property of a material. It is allowed by

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law to provided a support for the arguments by convincingly shown with an evidence in accordance with the authority stated in In re Schreiber, 44 USPQ2d.

IV. Applicant only argues and states on and for the record with respect to the property that an under coating layers in Mori et al is not changed after being heated by an infrared emitter. In the absence of an evidence to the contrary to the applicant's arguments with respect to the properties of the materials, the rejection over Mori (Pub. 2001/0010892 now Pat. 6,596,462) alone is withdrawn. However, the claims would have not value if someone later show or provide an evidence that there a change in an under coating layers as disclosed, taught or suggested in Mori et al after being heated by an infrared emitter.

V. In view of the amendment and arguments with respect "change...coating underlying", Ma et al (5,292,556), Arimatsu et al (5,312,654), Furukawa (5,695,908) and Miyabi et al (5,852,975) as the primary references are withdrawn.

VI. Applicant's arguments filed on 19 April 2006 have been fully considered but they are not persuasive.

The arguments and Papers filed on 19 April 2006 have no value until a petition to request to reinsert a benefit claim to a prior application is granted.

VII. Applicant's Papers filed on 22 May 2006 have been fully considered but they are not persuasive.

Papers filed on 22 May 2006 have no value until a petition to request to reinsert a benefit claim to a prior application is granted.

VIII. This is a Request for Continued Examination of applicant's earlier and same application disclosure and claims. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will

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be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
16 November 2006

HOA VAN LE
PRIMARY EXAMINER
